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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/602,426

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Phillip Clark

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MILLIPORE CORPORATION
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EXAMINER

HANDY, DWAYNE K

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

03/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/602,426	Applicant(s) CLARK ET AL.	
	Examiner DWAYNE K. HANDY	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,11-22 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 7 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 and 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 16 recite the limitation "the outer perimeter edge of said first sample processing device". There is insufficient antecedent basis for this limitation in these claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5, 6, 8, 9, 11-21 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Moring et al. (6,159,368). This rejection was upheld for claims 1-3, 5-9, 11, 12 and 16-21 in the previous Office Action (mailed 7/12/07). It now applies to claims 1-3, 5, 6, 8, 9, 11-21 and 25-27. Please see Response to Arguments below.

Inventorship

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moring et al. (6,159,368) in view of Vestal (5,498,545). This rejection was upheld in the previous Office Action (mailed 7/12/07). It remains in effect. Please see Response to Argument below.

Response to Arguments

8. Applicant's arguments filed 1/17/08 have been fully considered but they are not persuasive. Applicant has amended claim 1 to include the limitations of the collar and second seal being positioned on the outer perimeter edge of the first sample processing device. Applicant has then argued that these limitations distinguish the instant device over the prior art Moring. The Examiner respectfully disagrees and notes the following:

Claims 1 and 25 as written do not require gasket elements – but instead simply require a seal. Claim 16 also does not require gasket elements - but requires the collar be positioned on the outer perimeter edge of said first sample processing device. The element from Moring that the Examiner has used as the collar - frame (38) - includes clamps 34 and 36 (See Figure 2 and column 13, lines 50-59). **These clamps are positioned on the outer perimeter edge of the first sample processing device in a manner such that clamp 43 contacts the top of plate 10 to form a second seal (See Figure 3).** This is what claims 1, 16 and 25 require. Claim 7- which recites the second seal being a gasket - has been objected to as being allowable but dependent upon a rejected base claim. Moring does not show a second seal comprised of a

gasket positioned on the outer perimeter edge of the first sample processing device and between the sample processing device and the collar.

9. Re: Claim 13

The rejection of claims 13-15 under Moring was lifted by the Examiner in Paragraph 6 of the Office Action mailed 1/17/07. The claims were rejected in Paragraph 1 of the same action under USC 112, 2nd Paragraph however. Applicant then amended the claim to overcome the 112 rejection in the amended dated 4/16/07. The Examiner then removed the 112 rejection – but the Examiner should have reinstated the rejection under Moring. The Examiner therefore apologizes for any confusion resulting from not reinstating the rejection under Moring. This was an oversight by the Examiner. Claims 13-15 do indeed remain rejected. Applicant has addressed claim 13 in Arguments on page 10, lines 17-24. This argument is beyond the scope of the claim as written, however. **In amending the claim to overcome the 112 rejection, Applicant removed the limitation of the flange being in contact with and in the slot of the collar.** Claim 13 as written simply requires a ‘base having an outer peripheral flange and a side wall that form a groove’ in addition to “a collar slot having a gasket”. The Examiner submits that the surface (50) extending from the base is a flange that joins with the side wall of the base to form a groove at the joint. In addition, Moring teaches a gasket (42) that resides in a slot in the collar (frame 38).

10. Applicant has also argued that the Examiner has not met the requirements for a *Prima Facie* Case of Obviousness in combining Moring and Vestal (page 11 of Arguments). Applicant's arguments are not persuasive. The Examiner considers the use of the plate from Vestal with the device of Moring to be a "Use of known technique to improve similar devices (methods, or products) in the same way". See MPEP 2143 "Examples of Basic Requirements of a *Prima Facie* Case of Obviousness", Section C.

Moring teaches a sample well plate used to collect liquids from filtration. Vestal teaches a sample well plate that may hold liquids, but also provides additional features such as electrically conductive materials (column 3, line 58) or pin structures (column 4, lines 61-64) used with MALDI devices. The use of the plate from Vestal having the additional features would predictably result in a filtration device having a collection plate that allows for collection of liquids and then subsequent MALDI analysis simply by moving the plate from the filtration device to a MALDI device. This would be an improvement upon a collection plate that could not be used with a MALDI analysis system.

Allowable Subject Matter

11. Claims 23 and 24 allowed. These claims were deemed allowable in previous Office Actions. Claims 7 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE K. HANDY whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH
March 16, 2008

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

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